

REMARKS/ARGUMENTS

Applicant has received and carefully reviewed the Office Action of the Examiner mailed September 6, 2007. Claims 1-20, 29-30 and 35-46 are pending. Newly presented claims 35-46 correspond to previously pending claims 21-28 and 31-34, which were canceled in the Amendment-After-Final dated August 3, 2007 in an attempt to move this case to issuance. No new issues are raised and no new search is necessitated by this amendment. Reconsideration and reexamination are respectfully requested.

Rejection under 35 U.S.C. § 102(e)

On page 2 of the Office Action, the Examiner rejected claims 29- 30 under 35 U.S.C §102(e) as being anticipated by AndelmanLelek (NPL). Applicant respectfully traverses the rejection. AndelmanLelek is not a patent or a published patent application, and therefore it does not qualify as prior art under 102(e). The rejection is thus in error. In addition, the Examiner does not cite to AndelmanLelek in the body of the §102(e) rejection. Instead, the Examiner cites to passages in Hill et al. This is confusing. Applicants respectfully request clarification of this rejection in any subsequent Office Action.

Further, it is not clear that the AndelmanLelek reference is a "printed publication". MPEP § 2128 states:

A reference is proven to be a "printed publication" "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it" *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981) (quoting *I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738, 743, 148 USPQ 537, 540 (SDNY 1966)).

...

An electronic publication, including an on-line database or Internet publication, is considered to be a "printed publication" within the meaning of 35 U.S.C. 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 227, 210 USPQ 790, 795 (CCPA 1981) ("Accordingly, whether information is printed,

handwritten, or on microfilm or a magnetic disc or tape, etc., the one who wishes to characterize the information, in whatever form it may be, as a 'printed publication' * * * should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.'" (citations omitted).).

Applicants submit that, in the absence of any evidence to the contrary, the building proposal of AndelmanLelek does not appear to meet the definition of "printed publication". If the Examiner continues to rely on this reference, Applicants respectfully request that the Examiner provide sufficient proof of the dissemination of the proposal to show that it was available and accessible to persons concerned with the art, and that it was publicly available prior to the filing date of the present application (i.e. April 13, 2004).

Although Applicants respectfully disagree that claims 29-30 are anticipated by AndelmanLelek (NPL) or Hill et al., claim 29 has been amended to recite:

29. (currently amended) A method for testing an HVAC system for an inside space of a building prior to a heating season, the HVAC system having a heating component, the method comprising the steps of:
receiving a test request that is provided from a location remote from the building, and in response to receiving the test request:
activating the heating component at a time when the HVAC system would not normally call for heat; and
determining if the heating component is in compliance with a number of predetermined conditions.

AndelmanLelek does not appear to teach, disclose or suggest such a method. On page 7 of the Office Action, the Examiner cites to the Seasonal Testing paragraph on page 5 of AndelmanLelek. AndelmanLelek appears to relate to a proposal for building commissioning services at Ashland High School in support of a design and construction process. The Seasonal Testing paragraph calls for testing portions of systems that are weather dependent during the opposite season that they were originally installed. For example, AndelmanLelek states, "[i]f an air handling unit was commissioned during the summer a follow-up test would be performed during the winter for items such as the heating valve and damper controls." This, however, would appear to indicate that AndelmanLelek is not testing those components that are dormant or

that would not normally be called, particularly since a heating valve would normally be called (active) in the winter, and not in the summer. As such, AndelmanLelek appear to teach having the HVAC contractor return in the winter to test the heating valve, i.e. the season when the heating valve would normally be used (e.g. not dormant). The Seasonal Testing paragraph would appear to relate to part of the commissioning process in order to make sure that the systems that were originally installed during the construction process were stable during the season that they were intended to serve. The Seasonal Testing paragraph of AndelmanLelek does not appear to relate to on-going maintenance of the installed systems after commissioning is complete.

Clearly, the Seasonal Testing paragraph of AndelmanLelek clearly does not teach, disclose or suggest, receiving a test request that is provided from a location remote from the building, and in response to receiving the test request: activating the heating component at a time when the HVAC system would not normally call for heat; and determining if the heating component is in compliance with a number of predetermined conditions, as recited in claim 29.

On page 2 of the Office Action, the Examiner cites to paragraph [0004] of Hill et al. as suggesting the activating step, and paragraph [0032] as suggesting the determining step. However, after carefully review, Applicants must respectfully disagree. Notably, and on page 7 of the Office Action, the Examiner acknowledges that Hill et al. does not teach performing a test on the dormant component of the HVAC system in response to a test request.

In any event, paragraph [0004] of Hill states in full:

According to an embodiment of the invention, a system for remotely monitoring and controlling at least one HVAC device includes a server with communications access to an entry device and the at least one HVAC device; querying means for querying the at least one HVAC device for status information on a regular basis or when requested by a message from the entry device; and means for sending the status information to the entry device in response to the querying (emphasis added).

Nothing here teaches activating the heating component at a time when the HVAC system would not normally call for heat in response to receiving the test request, as the Examiner suggests. Instead, Hill et al. appear to teach a method in which an HVAC device is queried for status

information. See paragraphs 0004-0007. Hill et al. also teach "server 12 checks to see if a message has been received to display diagnostic information such as that shown in Fig. 7. If so, the database is queried in step 532 for the diagnostic information, after which the diagnostic information is sent in step 534." Emphasis added; see paragraph 0028. Hill et al. also state:

Status information on the HVAC devices which is contained in the unit database is either updated on a regular basis or when requested by a message from the entry device. That is, status information can be sent to the server by the HVAC controller on a regular basis, or the server can request the status information from the HVAC controller on a regular basis, in addition to or in place of the server requesting status information in response to a message from the entry device.

Emphasis added; see paragraph 0032. Hill et al. thus appear to teach a system in which status information is requested and provided. Hill et al. do not, however, appear to teach the specific method steps recited in 29 including, for example, activating the heating component at a time when the HVAC system would not normally call for heat in response to receiving the test request.

If the Examiner is considering the specific method steps recited in claim 29 to be inherent in Hill et al., Applicants submit that there is no basis for such an interpretation. MPEP 2112 IV. states:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

(Emphasis added). Applicants submit that the claimed method steps, including the step of activating the heating component at a time when the HVAC system would not normally call for heat in response to receiving the test request, is not necessarily present in Hill et al. It appears

the Examiner is asserting that the claimed method steps could be performed by the system of Hill et al., which is not a proper basis for rejection, especially for an anticipation rejection.

In the advisory action mailed July 10, 2007, the Examiner notes that during patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification". However, to date, the Examiner has not pointed out where Hill et al. specifically discloses the recited method step of, for example, activating the heating component at a time when the HVAC system would not normally call for heat in response to receiving the test request, as recited in claim 29. Certainly AndelmanLelek does not disclose such a step. Applicants submit that giving the claim the "broadest reasonable interpretation" does not negate the requirement that each and every element of a claim must be found in the art to support a rejection under §102 or §103. For these and other reasons, claim 29 is believed to be clearly patentable over AndelmanLelek and/or Hill et al. For similar and other reasons, claim 30 is believed to be clearly patentable over AndelmanLelek and/or Hill et al.

Rejection under 35 U.S.C. § 103

On page 2 of the Office Action, the Examiner rejected claims 1-20 as being unpatentable over Hill et al. in view of AndelmanLelek. Applicants respectfully disagree. However, in the interests of moving this case forward, claim 1 has been amended to recite:

1. (currently amended) A method for testing an HVAC system for a building structure from a remote location outside of the building structure, the HVAC system having an active component and a dormant component, the method comprising the steps of:
~~transmitting~~ receiving a test request ~~to the HVAC system~~ from the remote location;
performing a test on the dormant component of the HVAC system in response to the test request, and producing a test result, the test including activating the dormant component; and
transmitting the test result to a location outside of the building structure for subsequent analysis; and
~~storing the test result at the location outside of the building structure.~~

As can be seen, claim 1 recites the steps of: receiving a test request from the remote location; performing a test on the dormant component of the HVAC system in response to the test request, and producing a test result, the test including activating the dormant component; and transmitting the test result to a location outside of the building structure for subsequent analysis.

In order for a combination of references to render a claim obvious, each and every element of the claim must be present in the prior art references. See M.P.E.P. §2143.03. As detailed above, neither Hill et al. nor AndelmanLelek appear to disclose the recited method steps including, for example, the step of performing a test on the dormant component of the HVAC system in response to the test request, wherein the test includes activating the dormant component. Thus, for the reasons set forth above, as well as other reasons, claim 1 is believed to be clearly patentable over Hill et al. in view of AndelmanLelek. For similar and other reasons, dependent claims 2-20 are also believed to be clearly patentable over Hill et al. in view of AndelmanLelek.

Newly Presented Claims

Newly presented claims 35-46 correspond to previously pending claims 21-28 and 31-34, which were canceled in the Amendment-After-Final dated August 3, 2007 in an attempt to move this case to issuance.

New claim 35 (old claim 21) recites, in part, the specific method step of:

performing one or more tests on each of the HVAC systems in response to the test request, and producing a test result for each of the HVAC systems, wherein at least one of the one or more tests that is performed activates and tests one or more of the active or dormant component of an HVAC system

(Emphasis added). The Examiner previously asserted that the system of Hill et al. performs one or more tests on each of the HVAC systems in response to a test request, and that at least one of the one or more tests that is performed activates and tests one or more of the active or dormant components of an HVAC system. As noted in Amendment filed June 6, 2007, and contrary to the Examiner's previous assertions, Hill et al. do not appear to teach, disclose or suggest performing one or more tests on each of the HVAC systems in response to the test request,

wherein at least one of the one or more tests that is performed activates and tests one or more of the active or dormant component of an HVAC system, as recited in claim 35. The Examiner previously cited to paragraph 16, lines 6-7 for performing one or more tests on each of the HVAC systems in response to the test request. Paragraph 16 of Hill et al. states:

Referring to Fig. 1, an entry device 10 such as a WAP (Wireless Access Protocol) cell phone, a handheld computer, or a PDA (Personal Digital Assistant) connects to a server 12 either via the Internet or a GSM/Internet interface. Entry device 10 is any device that allows a user to enter or receive data, whether over wireless or wired communication paths. Server 12 in turn is connected to an HVAC device 14 through the Internet and/or some other communications link such as the GSM Network or POTS (plain old telephone system) network. A user uses the entry device 10 to access diagnostic or status information relating to HVAC device 14. Typical users include an individual owner who wishes to change a setpoint, a service technician who wishes to check diagnostic information, or a building supervisor who wishes to control a number of devices (emphasis added).

Emphasis added. At most, this passage of Hill et al. suggests accessing and checking diagnostic or status information related to an HVAC device 14. The diagnostic or status information would appear to be generated by the HVAC device 14 itself, and not in response to any request of Hill et al. Clearly, nothing in this passage of Hill et al. suggests performing one or more tests on each of the HVAC systems in response to the test request, as recited in claim 35. Rather, this passage of Hill et al. only suggests accessing and sending diagnostic or status information (that is likely self generated by the HVAC system at some previous time) upon request.

The Examiner also cited to column 4, paragraph 0028, lines 28-33, as suggesting that the one or more tests that is performed in response to a test request activates and tests one or more of the active or dormant component of an HVAC system. Notably, the exact portion of Hill et al. cited by the Examiner (column 4, paragraph 0028, lines 28-33) is not clear because column 4 does not contain paragraph 0028, and paragraph 0028 does not cover lines 28-33. Paragraph 0028 recites:

In step 530, server 12 checks to see if a message has been received to display diagnostic information such as that shown in Fig. 7. If so, the database is queried in step 532 for the diagnostic information, after which the diagnostic information is sent in step 534. Control then passes to step 524.

Notably, this passage of Hill et al. appears to suggest that the server displays diagnostic information in response to a request. This clearly does not teach, disclose or suggest performing one or more tests that activate and test one or more of the active or dormant components of the HVAC system in response to the test request, as recited in claim 35.

The Examiner also referred to paragraph 0007 of Hill et al. for teaching a system that activates and tests a primarily active or dormant component of the HVAC system in response to a test request. This portion of Hill et al. states:

[0007] According to an embodiment of the invention, a method for remotely monitoring and controlling at least one HVAC device includes the steps of (a) providing a server with communications access to an entry device and the at least one HVAC device; (b) querying the at least one HVAC device for status information on a regular basis or when requested by a message from the entry device; (c) sending the status information to the entry device in response to the querying; (d) checking for messages from the at least one HVAC device; (e) automatically updating a database in the server relating to a status of the at least one HVAC device on a regular basis in the absence of the message from the entry device; and (f) changing settings on the at least one HVAC device from the entry device.

Emphasis added. Merely querying for status information, checking for messages, and displaying diagnostic information in response to a request cannot be seen to anticipate or render obvious the claimed step of activating an HVAC component. Hill et al. appear to teach a system that monitors and obtains diagnostic information upon request, but does not appear to teach, disclose or suggest a step of activating a component in response to a test request, as recited in claim 35.

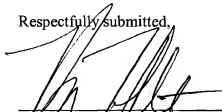
AndelmanLelek does not appear to supply with Hill et al. lacks. For these and other reasons, claim 35 is believed to be clearly patentable over Hill et al., and/or Hill et al. in view of AndelmanLelek. Newly presented claims 36-46 are believed to be clearly patentable over Hill et al., and/or Hill et al. in view of AndelmanLelek for reasons similar to those detailed above and in Applicants' Amendment filed June 6, 2007.

Reconsideration and reexamination are respectfully requested. It is submitted that, in light of the above remarks, all pending claims 1-20, 29-30 and 35-46 are in condition for

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allowance. If a telephone interview would be of assistance, please contact the undersigned attorney at 612-359-9348.

Respectfully submitted,



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